

App. No. 08/135,046
Amdt. dated: June 16, 2004
Reply to Office Action of April 5, 2004
Atty Docket No. 000594-125951
Page 2

REMARKS

Applicant notes the indication of allowable subject matter, i.e., claims 1-5, with appreciation. Reconsideration of the rejection of claims 6 and 9 is respectfully requested.

It is Applicant's understanding, both now and at the initiation of the interference in late 1994, that an application cannot be placed in interference with a patent unless applicant claims the same patentable invention as claimed by the patent.

From MPEP 2306(D):

"Since the claims of a patent may not be altered (except by reissue or reexamination), the applicant must claim the same patentable invention as is claimed in one or more claims of a patent in order to promote an interference with the patent. The fact that the patent may disclose subject matter claimed by the applicant is not a basis for interference if the patent does not claim that subject matter."

Throughout the previous prosecution of the present application and the prosecution of the several continuing patent applications of Cullen (up to and including the interference proceedings), the only claims that were deemed allowable were claims that included a pipe or conduit support, e.g., a reel mounted on the bagging machine.

Applicant herein could not have submitted the claims presently under consideration because any claim without the pipe support would not be considered a "patentable invention" as claimed in the one or more claims of the Cullen patents.

In the present application, the undersigned took every known precaution and, even further, discussed the issue of the present application having claims without the reel or pipe support element with an administrator of the Interference Division (Mr. Shaw or Mr. Cashion). The undersigned was told that as long as the claims with and without the subject element were patentably distinguished, Applicant could pursue the claims with the subject pipe support

App. No. 08/135,046
Amdt. dated: June 16, 2004
Reply to Office Action of April 5, 2004
Atty Docket No. 000594-125951
Page 3

element in the interference proceeding and further pursue claims without the pipe support element in a separate patent application. (See Exhibit A.) Thereafter and following initiation of the interference, Applicant diligently pursued the present application.

An appeal was filed and the appeal brief was submitted in this further application on October 7, 1996. As time passed for receiving the examiner's appeal brief, calls were made to the examiner as to the status of the appeal, such calls being made at least prior to 7/18/97, at which time it was learned that the Board of Interferences had the present application. A status inquiry was made on July 18, 1997 (see Exhibit B). Note the indication that the file was understood to have been reviewed by the Board of Interferences and then returned to the Application Branch.

Calls were subsequently made to the Board of Patent Interferences on 8/27/97 and again on 10/21/97 (see Exhibit C).

A further status inquiry was made on December 18, 1997 (see Exhibit D), with argument for releasing the application to continue prosecution before the Board of Appeals and further noting the missing element of the appealed claims.

With reference to the examiner's citation of MPEP 2363.03 under Estoppel, there are ten examples given where such estoppel is applicable and all pertain to interferences between applications. Specifically, there is not one instance suggesting that a party applicant was allowed to add a count that was not a claimed invention of the opposing patent. Reference is further made to CFR § 1.633(C)(5), noting that requiring an opponent to add a claim applies only to "an opponent who is an applicant." Further, under CFR § 1.637, and consistent with the above quote from MPEP 2306(D), at CFR § 1.637(e)(2):

App. No. 08/135,046
Amdt. dated: June 16, 2004
Reply to Office Action of April 5, 2004
Atty Docket No. 000594-125951
Page 4

"When the preliminary motion seeks an additional interference under § 1.633(e)(2), the motion shall: *** [v] Designate the claims of any patent involved in the interference which define the same patentable invention as each proposed count."

Still further, note MPEP 2307 Compliance With 35 USC 135(b):

"The explanation under 37 CFR 1.606(a)(6) must be considered by the examiner to determine whether the 'substantially the same subject matter' requirement of 35 USC 135(b) has been met. In order for an application claim to be for 'substantially the same subject matter' as a patent claim, it must contain all the material limitations of the patent claim."

In summary, it is Applicant's understanding that in an interference involving a patent, it is the patent's claims that determine the counts of the interference. Whereas wording changes are permitted, they must be consistent with the invention as claimed. The only claims considered patentable were claims that included the reel/pipe support. Both Applicant's claims and opposer's claims not including the reel were rejected as being not patentable. Applicant believes it is entitled to a claim that did not include the reel. The issued patent to Cullen dictated that the only counts that would be considered in the interference were counts directed to the patentable invention of the Cullen patent claims and definitely the reel or pipe support was a material limitation of the claims.

Applicant's present application, having claims not including the reel, was reviewed by the Interference Board and then released back to the Application Branch. Applicant discussed the situation with an administrator of the Board of Interferences and he, too, concurred in Applicant's pursuing claim coverage that did not include the reel limitation.

Applicant notes the quote by the examiner at page 6 of the Office Action but is not able to find this quote under the recited MPEP 2306. Notwithstanding, it is not understood how

App. No. 08/135,046
Amdt. dated: June 16, 2004
Reply to Office Action of April 5, 2004
Atty Docket No. 000594-125951
Page 5

Applicant can be considered "estopped" because he did not pursue a course of action that was not available.

Respectfully, estoppel applies only where an applicant "could have properly moved under 37 CFR § 1.633 or 1.634, but failed to do so" and such does not apply to Applicant's claims 6 and 9. Applicant could not have successfully moved to declare an interference on counts not including the reel/pipe support and the holding of interference estoppel should be withdrawn. Such action is respectfully requested.

Respectfully submitted,


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